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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/961,459 10/30/97 WU

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EXAMINER

MARCHESCHI, M

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 11/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/961,459

Applicant(s)
Wu et al.

Examiner
Michael Marcheschi

Group Art Unit
1755



☒ Responsive to communication(s) filed on Sep 13, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 21-44 is/are pending in the application.

Of the above, claim(s) 21-30 and 32-44 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Newly submitted claims 21-30 and 32-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The original invention was claimed as a glass and the newly submitted claims above are directed to gray scale masks, methods, microstructures and photo resists which are distinct and are classified in a different area.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-30 and 32-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim 31 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 31 is indefinite as to the phrase '2.4 to 10.2% total of photosensitivity inhibitors and RS suppressing agents with at least...' because the examiner is unclear as to if only TiO_2 or all the oxides following this phrase are used inhibitors and RS suppressing agents. In addition, are all these recited oxides photosensitivity inhibitors and RS suppressing agent or are they distinct from

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the above inhibitors and agents? If the recited oxides belong to the above group (inhibitors and agents), this above phrase should be rewritten. (i.e. and 2.4 to 10.2% total of photosensitivity inhibitors and RS suppressing agents, wherein said photosensitivity inhibitors and RS suppressing agents comprise...).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over either **(1)** Wu (771), **(2)** Wu (303), **(3)** Wu (517), **(4)** Wu (366) or **(5)** Wu (104) for the same reasons set forth in the previous office action which are incorporated herein by reference. This new claim is related to the original claims and contains all the subject matter defined in said original claims.

Applicant's arguments filed 9/13/99 have been fully considered but they are not persuasive.

Applicants argue that the claimed invention is not defined by the prior art references because the new claims are directed to the products of the glass. The examiner fails to see any distinction because the references are directed to HEBS glass articles and the broad interpretation of articles encompasses any article in which this glass is used. In addition, applicants new claims 21-30 and 32-44, which are directed to the products, are non-elected by original presentation and therefore no further comment is deemed necessary. With respect to the only claim that is directed to an original claim (claim 31), applicants fail to argue the overlapping ranges and the obviousness of the characteristics defined in the previous office action. In view of this, no comment is deemed necessary.

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In view of the teachings as set forth above, it is still the examiners position that the references reasonably teach or suggest the limitations of the rejected claim.

"A reference can be used for all it realistically teaches and is not limited to the disclosure in its preferred embodiments" See *In re Van Marter*, 144 USPQ 421.

Evidence of unexpected results must be clear and convincing. *In re Lohr* 137 USPQ 548. Evidence of unexpected results must be commensurate in scope with the subject matter claimed. *In re Linder* 173 USPQ 356.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Marcheschi whose telephone number is (703) 308-3815. The

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examiner can be normally be reached on Monday through Thursday between the hours of 8:30-6:00 and every other Friday between the hours of 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Mark L. Bell, can be reached at (703) 308-3823.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Michael Marcheschi

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MICHAEL MARCHESCHI
PRIMARY EXAMINER